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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/375,239 08/16/99 MUSSO

E P8910-9024

EXAMINER

IM22/0403

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SERGEANT, R

ART UNIT	PAPER NUMBER
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1711

17

DATE MAILED:

04/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/375,239

Applicant(s)

Musso et al.

Examiner

Rabon Sergeant

Group Art Unit
1711

☒ Responsive to communication(s) filed on Feb 9, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-7, 10, 12-18, 22, and 23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 10, 12-18, 22, and 23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The request filed on February 9, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/375,239 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what limitations are set forth by the subject matter of claim 3. Applicants' amendment has not clarified the language. Applicants have failed to clearly address the rejection.

3. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have specified the compositions of claim 1 as a Markush group. As such, the compositions of claim 1 are closed to the addition of other foaming compositions which do not fall within the species of the Markush group. Therefore, the compositions of claims 4-7 are considered to be excluded from claim 1.

4. Claims 12-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are improperly dependent from two claims. Applicants have failed to address this rejection.

5. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The dependency of the claims is confusing, since the claims embody selections that are independent of claim 3.

6. Claims 1, 2, 4, 6, 7, 10, 12-18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have used the wrong structural formula in connection with the recited compound name. For example, see VIII within claims 1 and 7.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 12, 13, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants'

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compositions IV, V, D, and E are disclosed. See abstracts. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

9. Applicants have argued that Klug et al do not disclose that the compositions will function as substitutes for CFC-11. In response, patentees' compositions are disclosed as being azeotropic; therefore, they comprise the same components in the same amounts as applicants' azeotropic compositions and, consequently, will inherently function as blowing agents to the same extent as applicants' compositions. Additionally, it is unclear with respect to exactly what patentable limitation the language pertaining to CFC-11 substitution conveys to the claim.

10. Since the prior art rejection is anticipatory, the 37 CFR 1.132 declaration is ineffective to remove the rejection. Furthermore, even if the rejections were obviousness rejections, the showings of the declaration are not commensurate in scope with the claims.

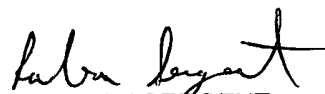
11. Claims 1-7, 10, 12-18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear with request to exactly what limitation is to be conveyed by "as substitutes for CFC-11".

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/dh

March 31, 2001


RABON SERGENT
PRIMARY EXAMINER